

[means] member including a radio frequency identification circuit which can be reused after the attachment [means] member has been disposed of. One form of the radio frequency identification device is an identification wristband which incorporates an attachment [means] member and a securement [means] member for said attachment [means] member, the securement[s] [means] member incorporating an RFID such as a chip which is removed from operative relationship with the attachment [means] member when the securement [means] member is removed to permit reuse of the securement [means] member and chip.

REMARKS

Applicant has amended the Abstract to eliminate the word "means" throughout the Abstract.

The Examiner has rejected claim 20 pointing out that, in lines 2-3, there is no antecedent for "circuit means". However, there is an antecedent, for the term "circuit means" in line 11 of base claim 19 on which claim 20 depends, line 11 reading "radio frequency identification circuit means" and claim 20 referring to the communication between the antenna and the radio frequency circuit means.

Applicant acknowledges the courtesy of an interview afforded by the Examiner which did not result in the acceptance of Applicant's argument regarding the allowability of the claims.

Applicant relies upon the amendments made in the preliminary amendment of February 24, 1999 and the further amendments and arguments incorporated in the

amendment of November 2, 1999 and the supplemental amendment of December 16, 1999.

However, in retrospect, despite the extensive discussion of the inapplicable nature of the prior art cited by the examiner, Applicant may have been remiss in not adverting to the present position of the Federal Circuit on the use of hindsight to reject the claims of the patent application.

As the examiner is indubitably aware, there are numerous decisions of the Federal Circuit reversing the Board of Patent Appeals and Interferences where the Board has supported an examiner in utilizing hindsight rejections. The numerous cases can be found in Vol. 11 of *Chisum on Patents* §1541.

One of the most comprehensive treatments of the "hindsight trap" is found In Re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

At pp. 1616-1617 50 USPQ2d, the Federal Circuit begins its analysis as follows:

Our analysis begins in the text of section 103 . . . with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight" . . . when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that

which only the inventor taught is used against its teacher."

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . . Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Board fell into the hindsight trap.

The examiner's hindsight rejections have gone far beyond those customarily encountered in that he suggests the mutilation of Hayes to support the 102 rejection

ignoring the fact that every limitation of the rejected claims must be found in the prior art reference.

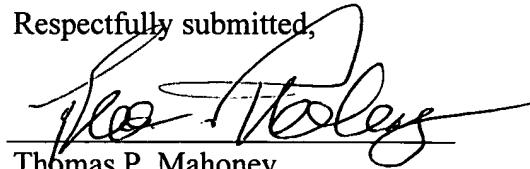
In addition, there is not to be found in any of the references cited by the examiner in his 103 rejection any suggestion whatsoever of the concept of a securement member embodying an RFID and separable from the attachment member which it is intended ~~to~~  ~~secure~~ to permit the securement member and the embedded RFID to be reused time and time again.

It is respectfully suggested that, in the absence of such teaching and in the need for reconstruction of the prior art adverted to by the examiner, that the rejection of the claims on the prior art is not well founded. Reconsideration and allowance of the claims of the application are respectfully requested.

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Respectfully submitted,


Thomas P. Mahoney
Attorney at Law
Reg. No. 15,513
660 Newport Center Dr., Suite 710
Newport Beach, California 92660
949-718-1120

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